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PATENT APPLICATION
09/315,806

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

re Application of: Martin M. Deneroff, et al.
Serial No.: 09/315,806
Filing Date: May 21, 1999
Group Art Unit: 2181
Examiner: Paul R. Myers
Title: SYSTEM AND METHOD FOR PROVIDING
ACCESS TO A BUS

Assistant Commissioner for Patents
Washington, D.C. 20231

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Dear Sir:

REPLY BRIEF

In response to the Examiner's Answer dated November 1, 2002, Applicant respectfully submits this reply brief to address new points of argument raised in the Examiner's Answer.

NEW POINTS OF ARGUMENT

1. The Examiner has raised new points of argument with respect to the ability to combine the Amini, et al. and Trantanella patents.

2. The Examiner has raised new points of argument with respect to the references being in the field of endeavor of the claimed invention or pertinent to the particular problem being solved by the claimed invention.

3. The Examiner has raised new points of argument with respect to hindsight reconstruction of the claimed invention.

4. The Examiner has raised new points of argument with respect to the proposed modification changing the principle of operation of the prior art.

5. The Examiner has raised new points of argument with respect to the reasonable expectation of success of the proposed combination.

6. The Examiner has raised new points of argument with respect to the proposed combination having a switch to control access to a bus.

7. The Examiner has raised new points of argument with respect to continuous access to a bus of the Amini, et al. and Trantanella patents.

8. The Examiner has raised new points of argument with respect to the Amini, et al. patent having no element to control access to the bus.

9. The Examiner has raised new points of argument with respect to the in-out buffers of the Trantanella patent being always connected to the bus.

10. The Examiner has raised new points of argument with respect to the references failing to show all features of the claimed invention.

REMARKS

1. The Examiner states, citing old CCPA cases, that there is no requirement that a motivation to combine references be expressly articulated. However, the Court of Federal Appeals has expressly stated that the Examiner is required to show a motivation to combine the references that create the case for obviousness. *In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1998). "In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." Id. at 1357. Three possible sources for a motivation to combine references have been identified by the court - the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. Id. The Examiner has merely stated that it would be obvious to one of ordinary skill in the art to combine the teachings of the Amini, et al. and Trantanella patents. It is well settled that there be some specific understanding or technical principle within the knowledge of one of ordinary skill in the art to suggest the proposed combination. Id. Merely stating that it would have been obviousness to one of skill in the art to combine the references, without more, is not sufficient to support an obviousness rejection. The requirement that there be a suggestion to combine the references is a safeguard that prevents the Examiner from performing an improper hindsight reconstruction of the claimed invention in support of an obviousness rejection. Id. at 1358. The Examiner has not articulated any suggestion to combine the Amini, et al. and Trantanella patents as required for a proper rejection based on obviousness.

2. The Examiner states that both the Amini, et al. and Trantanella patents are directed to connecting devices to a bus. However, the devices in both the Amini, et al. and the Trantanella patents are always connected to and accessible by a different type of bus with different protocol requirements. The Amini, et al. patent requires an arbitration process in order to perform communications over its bus while the Trantanella patent allows for freedom of communication without requiring any arbitration. Thus, the Amini, et al. and Trantanella patents are not in the same field of endeavor. Moreover, because of their continuous connection to and access by their respective busses, the Amini, et al. and Trantanella patents do not address the problem of controlling access to a bus as presented in the claimed invention.

3. The Examiner states that hindsight reconstruction is proper if it takes into account only knowledge of one skilled in the art at the time of the invention and does not include knowledge gleaned only from the Applicant. However, the Examiner has not provided any information relating to the knowledge of one skilled in the art. In fact, the Examiner is trying to force feed the references to read on the claimed invention using purely subjective conjecture. Without any information as to the knowledge of one skilled in the art, the only conclusion that can be made is that the rejection of the claims based on obviousness is an improper hindsight reconstruction supported only from the knowledge provided by the Applicant.

4. The Examiner states that the switches of the Trantanella patent would merely provide electrical isolation for the bus scheme of the Amini, et al. patent. However, the Trantanella patent uses gate amplifiers that do not have a

capability to isolate a device from its bus. The device is always connected to the bus with the gate amplifier merely determining whether the device receives information from the bus or output data from the device is placed on the bus. Moreover, the free communication scheme of the Trantanella patent is in direct contrast to the arbitration technique of the Amini, et al. patent. In this manner, there would be a change in operation of the prior art for the proposed combination. Since a change in the principle of operation of the prior art occurs, the teachings of the references are not sufficient to support the obviousness rejection.

5. The Examiner states that one would expect to use the gate amplifier of the Trantanella patent for isolation in the Amini, et al. patent. However, as discussed above, the gate amplifier of the Trantanella patent does not provide the isolation desired by the Examiner. Moreover, the Examiner has not provided any objective reasoning whatsoever that a reasonable expectation of success could be achieved by the proposed combination. The Examiner's subjective belief that there is a reasonable expectation of success, without any support, still lacks a showing of how the incompatible processing techniques of the Amini, et al. and Trantanella patents would have a reasonable expectation of success upon combination.

6. The Examiner states that the Trantanella patent has a gate amplifier to control access of a device to a bus. However, the device of the Trantanella patent has continuous access to its bus. See BUS₁ 120 always connected to inverter 122 and input lines IN₁ of the device. The gate amplifier of the Trantanella patent merely determines whether output information from the device is placed on the continuous bus

access connection. Thus, the Trantanella patent has no support for a switch controlling access of a device to a bus as required by the claimed invention.

7. The Examiner states that The Amini, et al. and Trantanella patents enable and disable access to a bus. However, the Amini, et al. patent merely controls enabling or disabling device communication capabilities. The device itself still maintains continuous access to a bus whether or not it is allowed to communicate thereon. See FIG. 1C of the Amini, et al. patent. As stated above, the Trantanella patent also has continuous access to a bus. Its output enable signal merely enables or disables an output communication capability from the device. The device of the Trantanella patent still has continuous access to the bus whether or not the output is enabled or disabled.

8. The Examiner states that the Amini, et al. patent teaches enabling access to the bus. Contrary to the Examiner's assertion, the Amini, et al. patent merely teaches controlling a communication capability on its bus. As stated above, the devices of the Amini, et al. patent have continuous access to its bus with no ability to control this continuous access as required by the claimed invention. As shown above, the gate amplifier of the Trantanella patent controls only an aspect of a communication capability of a device and has no influence on the continuous access to the bus.

9. The Examiner states that the in-out buffers of the Trantanella patent are not connected to the bus when the gate amplifier is not enabled. However, as stated above, the Trantanella patent clearly shows that its device continuously accesses the bus regardless of whether its gate amplifier is

enabled or disabled. BUS₁ 120 of the Trantanella patent is still accessible to the device at the connection to inverter 122 and input signal IN₁. Thus, the in-out buffers of the Trantanella patent are always connected to the bus.

10. The Examiner states that features relied upon are not found in the claims. Applicant is not relying on features not found in the claims but on the elements specifically presented therein. The Examiner has failed to show how the Amini, et al. and Trantanella patents support each of the limitations found in every dependent claim.

CONCLUSION

Applicant has clearly demonstrated that the present invention as claimed is clearly distinguishable over all of the cited art of record, either alone or in combination. Therefore, Applicant respectfully requests the Board of Patent Appeals and Interferences to reverse the final rejection of the claims and instruct the Examiner to issue a Notice of Allowance of all pending claims in this Application.

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The Commissioner is hereby authorized to charge any amount required or credit any overpayment to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.

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January 2, 2003

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Dear Sir:

CERTIFICATE OF MAILING BY EXPRESS MAIL

I hereby certify that the attached Reply Brief is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. §1.10 on this 2nd day of January 2003, addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

Willie Jiles
Willie Jiles

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